



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

STANTON B. DOTSON, *et al.*

Appl. No.: 09/912,968

Filed: 07/25/2001

For: Methods for Assessing Transgene  
Expression and Copy Number

Art Unit: 1634

Examiner: SHEINBERG, MONIKA B.

Atty. Docket: 38-21(51862)B

### Response to Restriction Requirement

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed August 26, 2003, Applicants submit the following remarks.

#### *Remarks*

The application presently contains claims 35-50. In the Office Action mailed August 26, 2003, the Examiner required restriction to one of the following inventions under 35 U.S.C. § 121:

Group I: Claims 35-50, drawn to a method to detect expression of a transgenic nucleic acid molecule in a sample using hybridization to a 3' untranslated sequence from the 3' end of the *Pisum sativum* rbcS E9 gene (SEQ ID NO: 2) and its corresponding oligonucleotide (one of

SEQ ID NO: 7-12, 26-28), classified in class 435, subclass 6;

Group II: Claims 35-50, drawn to a method to detect expression of a transgenic nucleic acid molecule in a sample using hybridization to a *Petunia* HSP70 5' untranslated leader sequence (SEQ ID NO: 5) and its corresponding oligonucleotide (one of SEQ ID NO: 7-12, 26-28), classified in class 435, subclass 6; and

Group III: Claims 35-50, drawn to a method to detect expression of a transgenic nucleic acid molecule in a sample using hybridization to a wheat fructose 1,6-biphosphatase 5' untranslated leader (SEQ ID NO: 32) and its corresponding oligonucleotide (one of SEQ ID NO: 7-12, 26-28), classified in class 435, subclass 6;

Group IV: Claims 35-50, drawn to a method to detect expression of a transgenic nucleic acid molecule in a sample using hybridization to a 3' untranslated sequence from the wheat ubiquitin gene (SEQ ID NO: 33) and its corresponding oligonucleotide (one of SEQ ID NO: 7-12, 26-28), classified in class 435, subclass 6; and

Group V: Claims 35-50, drawn to a method to detect expression of a transgenic nucleic acid molecule in a sample using hybridization to a 3' untranslated sequence from the nopaline synthase gene (SEQ ID NO: 35) and its corresponding oligonucleotide (one of SEQ ID NO: 7-12, 26-28), classified in class 435, subclass 6.

Applicants respectfully traverse the restriction requirement, and provisionally elect Group I (claims 35-50 drawn to SEQ ID NO: 2 and its corresponding oligonucleotide SEQ ID NO: 7) for further prosecution.

Applicants submit that the complete examination of the application would be handled most expeditiously by treating all of the pending claims as a single entity. As Section 803 of the

MPEP directs, “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” Applicants respectfully submit that the Examiner has not shown that a search and examination of the entire application would cause a serious burden. Rather, a serious burden would arise if the application were restricted.

Applicants submit that the restriction requirement is inappropriate. For example, Applicants contend that, at least, all the corresponding oligonucleotides (SEQ ID NO: 7, 8, 9, and 28) for a single untranslated sequence should be examined simultaneously because they are related as being used in the method to detect expression of a transgene nucleic acid molecule in a sample. Furthermore, Applicants submit that restriction to a single untranslated sequence is improper and Applicants believe no serious burden would result by the search and examination of the 5 untranslated sequences (SEQ ID NO: 2, 5, 32, 33, and 35). Applicants disagree that each nucleotide sequence and its corresponding oligonucleotides in the application is necessarily a patentably distinct species, but provisionally elect the species of Group I (SEQ ID NO: 2 and its corresponding oligonucleotide SEQ ID NO: 7) for further prosecution.

Based upon the foregoing, Applicants submit that the restriction requirement is improper and therefore should be withdrawn. To facilitate prosecution, however, Applicants have provisionally elected, with traverse, Group I (claims 35-50 drawn to SEQ ID NO: 2 and its corresponding oligonucleotide SEQ ID NO: 7).

Should the Examiner have any questions regarding this application, the Examiner is encouraged to contact Applicants' undersigned representative at (314) 694-6343.

Respectfully submitted,



DATE: 9/25/2003

Pamela J. Sisson  
(Registration NO. 53,600)

Patent Department E2NA  
MONSANTO COMPANY  
800 N. Lindbergh Blvd.  
St. Louis, MO 63167  
Telephone: (314) 694-6343  
FAX: (314) 694-1671



Image

1634

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re applications of:

Stanton B. Dotson et al.

Appln. No.: 09/912,968

Filed: 07/25/2001

For: Methods for Assessing Transgene Expression  
And Copy Number

Art Unit: 1634

Examiner: Sheinberg, Monika B.

Atty. Docket: 38-21(51862)B

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22314-1450

**Certificate of Mailing**

I hereby certify that this Response to Restriction Requirement, is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

on

9-25-03

Gracie L. Williams

(Printed name of person signing this certificate)

Gracie L. Williams

(Signature)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Re: U.S. Utility Patent Application No. 09/912,968  
Filed: 07/25/2001  
For: Methods for Assessing Transgene Expression And Copy Number  
Inventors: Stanton B. Dotson *et al.*  
Atty. Docket: 38-21(51862)B

Sir:

Transmitted herewith for appropriate action by the U.S. Patent and Trademark Office (USPTO) are the following documents:

1. Response to Restriction Requirement (dated 8/26/2003 );
2. Certificate of Mailing for Response to Restriction Requirement; and
3. (1) Return receipt-postcard.

It is respectfully requested that the attached postcard be stamped with the date of Filing of these documents, and that it be returned to us. In the event that extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned.

The Commissioner is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 13-4125, referencing matter number 38-21(51862)B.

Respectfully submitted,



Pamela J. Sisson (Reg. No. 53,600)

Date: 9/25/2003

Patent Department, E2NA Monsanto Company  
800 N. Lindbergh Blvd.  
St. Louis, Mo. 63167  
Tel: 314-694-6343  
FAX: 314-694-1671